



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,157	06/25/2003	Janelle Gunther	10021057-1	5605
22878	7590	05/16/2005	EXAMINER	
AGILENT TECHNOLOGIES, INC. INTELLECTUAL PROPERTY ADMINISTRATION, LEGAL DEPT. P.O. BOX 7599 M/S DL429 LOVELAND, CO 80537-0599			ZEMEL, IRINA SOPJA	
		ART UNIT	PAPER NUMBER	
		1711		
DATE MAILED: 05/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/607,157	GUNTHER, JANELLE
	Examiner	Art Unit
	Irina S. Zemel	1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 June 2003.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6-25-2003.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the first and the second self-assembling molecules having or sharing the same back-bone structure, does not reasonably provide enablement for any possible pairs of self assembling molecules. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification provides enablement for the pairs of self-assembling first and the second molecules, where the first and the second molecules are each self-assembling and they both share a common back-bone structure. However, the specification provides no guidance on how to select the first and the second molecules so that they can together self-assemble into an ordered structure. While there is a large number of different self-assembling molecules, including molecules of simple or complex backbone structure currently known in the art, it would require undue experimentation to determine which specific first and second molecules among known self-assembling molecules would together assemble in a ordered composite structure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said covalent bonding functionality" in step (b). There is insufficient antecedent basis for this limitation in the claim. Furthermore, it is not clear whether the "cross-linking functionality" in step (a) is the same or different from the recited "covalent bonding functionality" of step (b).

Claim 3 is confusing. Not only the recitation "said two or more nanopores" lacks antecedent basis, the meaning of this recitation is not understood since it is not defined anywhere in the specification. Claim 3 so confusing in its meaning so it is withdrawn from further examination on the merits.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5-11 and 13-20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,653,358 to Bzura et al., (hereinafter "Bzura").

The reference discloses a method of forming nanoporous structures by combining a first functionalized matrix molecule with a porogen molecule having no

Art Unit: 1711

functional groups, bonding or crosslinking the matrix and removing the porogen molecules thus producing nanoporous structures. The reference expressly teaches that the matrix and the porogen molecules can be self-assembling molecules. See, for example, column 7, line 42 et seq. Illustrative examples disclose sheets and nano objects disclosed as structures obtained from the method taught by the patentee. The molecules suitable as the matrix and the porogen molecules are disclosed as linear molecules and from the molecular weight of the porogen the limitation of the molecule length is inherently met by the disclosed porogen molecules. See, for example, columns 4-7 for the matrix structure, columns 7-8 for the porogen structure, and column 9, line 30-37 for lower limits on porogen molecular weight.

As far as the kit claims 17-20, the reference anticipates these claims as per discussion of method claims above, since it has been established by the court that the content of written instructions was not patentable subject-matter that could be relied upon to overcome a prior art rejection of a biotech kit claim. *In re Ngai and Lin* (Fed Cir 03-1524, decided March 8, 2004, precedential opinion issued May 13, 2004).

The invention as claimed in claims 1,2 , 5-11 and 13-20 is, therefore, anticipated by the disclosure of Bzura.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bzura.

The disclosure of Bzura is discussed above. The reference expressly teaches that the pore size in the preferred embodiments does not exceed 10 nm (see column 10, lines 55-59), thus rendering anything below 10 nm, including the claims diameter of 5 um obvious absent showing of unexpected results that can be attributed to the pore size.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ISZ



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700